



PATENT
P51671RE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of: JIN-SU PARK

Appeal No. 33

Original Patent: U.S. Patent No. 5,719,618 issued on the 17th of February 1998

Serial No.: 09/506,288

Examiner: BUCZINSKI, S.

Filed: 17th of February 2000

Art Unit: 3662

For: LOCKING METHOD FOR A SYSTEM WITH AN ON SCREEN DISPLAY
FUNCTION AND APPARATUS THEREFOR

Attn: Board of Patent Appeals & Interferences

APPEAL BRIEF

Commissioner for Patents
Washington, D.C. 20231

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Sir:

Pursuant to Appellant's Notice of Appeal filed on the 9th of December 2002, Appellant hereby appeals to the Board of Patent Appeals and Interferences from the final rejection of claims 20, and 44 through 58, as set forth in the final Office action mailed on the 9th of July 2002 (Paper No. 24) and the Advisory Action mailed on 21st of November 2002 (an unnumbered Paper). Claims 1 through 19, 21 through 43, and 59 have been allowed as set forth in the final Office action mailed on 9 July 2002 (Paper No. 24) and the Advisory Action mailed on the 21st of November 2002 (an unnumbered Paper).

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I. REAL PARTY IN INTEREST

Pursuant to 37 CFR §1.192(c)(1)(as amended), the real party in interest is:

SamSung Electronics Co., Ltd.
#416, Maetan-dong, Paldal-gu
Suwon-city, Kyungki-do, Republic of KOREA

as evidenced by the Assignment executed by the inventor on 5 August 1989 and recorded in the U.S. Patent & Trademark Office on 28 August 1989 at Reel 5697, frame 121/122.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals and no interferences known to Appellant, Appellant's legal representatives or the assignee which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

The attention of the Board is invited to Paper No. 35 issued on the 22nd of July 1997 in Applicant's Appeal No. 95-1187 based upon the patent application serial no. 08/024,495. In the *Findings of Fact and Conclusion of Law* (Paper No. 35), the Board gave very careful consideration to then claim 8, which was re-numbered and issued as claim 7 in Applicant's U.S. patent 5,719,618.

III. STATUS OF CLAIMS

Claims 1 through 59 are pending in this reissue application. Claims 1 through 19, 21 through 43, and 59 have been allowed.

Reissue claims 20, and 44 through 58 stand finally rejected. Of the latter claims, claims 20, 44, 48, 55, and 56 are independent, whereas the remaining claims are dependent. Claims 1 through

19 and 21 through 43, and 59 are allowed, as stated in the final Office action mailed on 9 July 2002 (Paper No. 24) and the Advisory Action mailed on 21 November 2002 (Paper No. 97).

Rejected reissue claims 20, and 44 through 58 are set forth in the annexed Appendix to this Appeal Brief.

Allowed claims 1 through 19, 21 through 43 and 59 have been presented in a continuing reissue application newly filed on the 7th of January 2003, and has been assigned Serial No. 10/337,364. Appellant has received no examination of the continuing reissue application as of the filing date of this Appeal Brief.

IV. STATUS OF AMENDMENTS

No amendments of any claims were made subsequent to the final rejection (Paper No. 24). It may be noted that in Paper No. 24 the Examiner objected to the preposition "of" in line 1 of allowed claim 1; Appellant's Amendment filed on or about the 6th of November 2002 restored the preposition –for– in place of "of".

In the Advisory Action dated 21 November 2002 (Paper No. 27), the Examiner stated that the proposed Amendment overcame objection to claim 1, and that upon "the filing an appeal, the proposed amendment will be entered in part, otherwise the arguments will not be entered" The Examiner gave no basis for refusing to enter those arguments, and it is difficult to understand whether the Examiner literally meant that the Remarks contained in Appellant's Amendment of the 6th of November 2002 had not been entered.

On the 10th of February 2003, filed a Response containing no amendments, but directed to

the final rejection set forth in Paper No. 24 and the Advisory Action set forth in Paper No. 27. In an Advisory Action dated on the 26th of February 2003, the Examiner maintained the final rejection of claims 20 and 44 through 58, and stated that “[u]pon the filing of an appeal the proposed amendment will be entered in part, otherwise the arguments will not be entered.” The Examiner did not explain what “amendment will be entered in part” when Applicant’s response of the 10th of February 2003 contained no amendment of any claim.

V. SUMMARY OF INVENTION

The present invention relates to the locking method for a system with on-screen display (OSD) function, especially to a system-locking method using the OSD function without requiring an additional display unit for the systems such as video tape recorder (VTR), etc. having an OSD function.

The overall disclosure may be best understood by referring to the especially succinct statement written by the Board in paragraph 5, on page 2 of the *Findings of Fact And Conclusions Of Law* (Paper No. 35) issued by the Board on the 9th of June 1997, “[t]he subject matter of the invention is a locking method for a system with an on-screen display, such as a videotape recorder (“VTR”). According to Applicant,

The locking device on a VTR is generally used for the purpose of keeping children from watching adult video programs, by preventing their reproduction. The conventional locking device for the above purpose is used to display the status of the

secret codes being inputted by the viewer on an additional display unit [,] such as a digitron, when locking or unlocking the VTR. Meanwhile the character generator circuit is generally incorporated in the video processing system such as [a] VTR or digital television for displaying warning information, channel or other character information on a monitor.

(Paper 1 at 1.) Applicant provides an algorithm for operating a device that uses the VTR or television display instead of an additional display unit.”

Recognition should be given to the variance between the finally rejected claims 20 and 44 through 58, from the subject matter of patent claim 7 described by the foregoing characterization of Applicant’s disclosure, excerpted from the decision of the Board. A more detailed description is found in Appellant’s *Reply Brief* filed on the 25th of October 1994, which encompasses the subject matter defined by patent claims 7 as well as finally rejected reissue claims 20 and 44 through 58. The finally rejected reissue claims define subject matter found in Figs. 1 through 4 collectively. Applicant’s disclosure is briefly outlined in Fig. 1 (page 4, lines 1-11) wherein the system waits (11) for a lock-function call, stores and displays a secret code being input (12) by the user after receipt of the lock-function call, and determines whether the system is in a locked or unlocked state upon completion of the input of the secret code (13). Then, if it is determined that the system is in an unlocked state the input secret code is memorized (14) (*i.e.*, temporarily stored) and the system is locked, or if the system is determined to be in the locked state the (temporarily stored) input secret code is compared (15) with a previously memorized code. If the codes do not match an error message is displayed (16) and the system remains locked; however if the codes do match the system

is unlocked (17) so that it can be used.

While waiting for a lock-function call (11) a microcomputer (100, Fig. 2) checks a power-flag (200, Fig. 3A), which indicates that the system is in a power standby state if it is set to "1". If the microcomputer determines the power-flag is set to a "1" logical state, then the microcomputer checks for input of key data (201, Fig. 3A). When mode of operation receives key data input while in the power standby state mode of operation, the microcomputer determines whether the key data is input from a lock key (202, Fig 3A) on a keyboard (101, Fig. 2). If the key data is determined not to be from the lock key, then the system remains in the power standby state as long as the power-flag is set to "1" (see Page 7, lines 13-25). If the key data is determined to have been from the lock key mode of operation then the system displays prompt messages (300-303, Fig. 4) for each number of the secret code, one at a time (208, 213, 218 and 223, Fig. 3A). Upon entry of a numerical value according to user selection of a numerical key on the keyboard in response to each prompt, individually, the numerical value of the numerical key is individually displayed seriatim (301, 302, 303, and 304, Fig. 4), and stored in a respective register (211, 216, 221, and 226, Figs. 3A and 3B). Then, a sequential prompt message is displayed to prompt the user to input the next numerical value of the secret code, until the last value of the secret code is stored in its respective register (226, Fig. 3B) (see page 8, line 7 through page 11, line 5).

When the last numerical value has been successfully stored in its register, the microcomputer checks the status of a lock flag (page 11, lines 12-14), which indicates a system locked state when the lock flag is set to "1" (228, Fig. 3B).

If the mode of operation determines that the lock flag is not set to "1", which indicates that

the system is in an unlocked state, then the lock flag is set to "1", thereby locking the system (229, Fig. 3B), memorizes the input secret code (232, Fig. 3B) and clears (233, Fig. 3B) the display (page 11, line 15 through page 12, line 10).

If the mode of operation determines (228) that the lock flag is set to a "1" however, then the input secret code temporarily stored in the registers is compared with the previously memorized secret code (234, Fig. 3B). If the comparison indicates that the codes do not match, then an error message is displayed (236, Fig. 3B). If however, the codes do match, the lock flag is reset, *i.e.* set to "0" (237, Fig. 3B), the system is unlocked (239, Fig. 3B), and the secret code is cleared (241, Fig. 3B) from the display (page 12, line 11 through page 13, line 19).

VI. ISSUES

I. Were Claims 21 and 44 Through 58 Improperly Rejected Under 35 U.S.C. §251?

- A. Does 35 U.S.C. §251 Prohibit The Allowance Of Reissue Claims That Are Broader In Scope Than The Patented Claims?**
- B. Does 35 U.S.C. §251 Require That Reissue Claims Which Are Broader In Scope Than The Patent Claims Contain All Of The Constituent Elements Of The Narrowest One Of Those Patent Claims, Even Though The Reissue Claims Are Directed To Subject Matter That Is Different From That Defined By The Patent Claims?**
- C. Does 35 U.S.C. §251 Prohibit Allowance Of Reissue Claims That Are Patentably Distinguishable Over The Prior Art For Reasons That Are Different From The Reasons For Allowance Of The Patent Claims?**

II. Is There Evidence In The Instant Record That Fairly Justifies A Rejection Of Claims 21 And 44 Through 58 Under The Doctrine Of Reissue Recapture?

- D. Did The Examiner Correctly Follow The Procedure Established By The Commissioner Of The United States Patent & Trademark Office For Making A Determination Of An Improper Recapture Under 35 U.S.C. §251?**
- E. Where Appellant Correctly Demonstrated That The Prior Art Fails To Teach What An Office Action Represented That Art As Allegedly Teaching, Does Appellant's Demonstration Of Those Omissions In The Art Thereafter Create A Recapture Estoppel That Restricts The Scope Of Reissue Coverage To Only Reissue Claims That Recite Each And Every Item That Was Found Lacking In The Prior Art's Teaching?**
- F. Where the Office Action Fails To Make A Finding Of In What Aspects The Reissue Claims Are Broader Than The Patent Claims, And Fails To Provide Evidence That The Broader Aspects Relate To Surrendered Subject Matter, The Rejection Must Be Withdrawn?**
- G. May A Recapture Rejection Under 35 U.S.C. §251 Be Maintained Where The Office Action Fails To Make A Finding Of Which Aspects Of The Reissue Claims Are Broader Than The Patented Claims, And Fails To Provide Evidence That The Broader Aspects Relate To Surrendered Subject Matter?**
- H. Is This Particular Recapture Rejection of Claims 21 And 44 Through 58 Under 35 U.S.C. §251 An Improper, Back-door Attempt To Revive The *Point-of-novelty* Criterion For Patentability?**
- I. Do Alternative Statements Made By An Appellant To Explain The Impropriety Of A Rejection Under 35 U.S.C. §102 Constitute An Amendment Of The Rejected Claim Or Constitute A Surrender Of Patentable Subject Matter Under 35 U.S.C. §251?**
- J. Even Ignoring Arguendo A Lack Of Basis For Imposition Of A Rejection Under 35 U.S.C. §251 And The Doctrine Of Recapture, And A Failure Of The Examiner To Follow The Mandated Procedure Under *MPEP* §1412.02, Do Claims 21 And 44 Through 58 Each Define At Least One Of The Constituent Aspects Required By The Examiner To Avoid Recapture?**

VII. GROUPING OF THE CLAIMS

The claims do not stand or fall together, and thus the claims are grouped as follows:

Grouping of the Claims

In accordance with 37 C.F.R. §1.193(c)(7), independent claim 20 was separately examined in the Office action (Paper No. 19) dated 7 February 2002, while independent claims 44, 48, 55 and 56 and their dependent claims 45 through 47, 49 through 54 and 57 through 58 were examined together in Paper No. 19. Accordingly, claim 20 stands or falls independently of claims 44 through 58 for the reasons set forth pursuant to 37 CFR §1.193(c)(8) in the following arguments.

Each of independent reissue process claim 20, 44, 48, 55 and 56 are directed to different aspects of Applicant's invention, and stand or fall separately, for the following reasons. Independent process claim 20 is directed to the response to the selective generation of a code in dependence upon an evaluation of content portrayed by a video signal. This combination is not found in patent claim 7.

Independent claims 44 and 48 focus upon the generation of first and second lock-key data signals, mixing of the corresponding first and second character signals corresponding to the first and second lock-key signals, in combination with subsequent determinations. In claim 44, Applicant makes a determination of whether the second lock-key signal is identical to the first lock-key signal and locks the video signal and prevents mixing in dependence upon the determination. In independent claim 48 however, Applicant makes a determination of whether the system is in a locking or unlocking state, and changing that state in accordance with the determination.

Process claim 55 makes a determination of coincidence between the second lock-key data signal and a reference, and locks or unlocks the video signal in dependence upon that determination, as well as defines the corresponding consequences of the locking and unlocking states upon the

mixing of a video signal. This concept is not present in the other independent claims or in patent claim 7.

Independent claim 56 defines the generation of the first and second lock-key data signals, the mixing of the corresponding character signals with video signals, and the effect of changing the locking and unlocking state upon dissemination of an audio signal. These aspects are present neither in patent claim 7 nor in the other finally rejected process claims. Consequently, both claims should be considered separately and stand or fall independently.

VIII. ARGUMENT

I. Claims 20, And 44-58 Were Improperly Rejected Under 35 U.S.C. §251.

Claims 20 and 44 through 58 stand finally rejected under 35 U.S.C. §251 as being drawn to recaptured subject matter. This rejection is improper for the following reasons.

A. Does 35 U.S.C. §251 Prohibit The Allowance Of Reissue Claims That Are Broader In Scope Than The Patented Claims?

First, 35 U.S.C. §251 allows reissue claims broader in scope than the patented claims in support of this rejection, the Examiner states that:

“The essential reasons argued for the allowability of the originally patented claims 2-7 and 9 according to Appellant exist in the amendment filed 21 October 1993 in the parent file and in the Opinion of the Board of Appeals as to originally numbered claim 8 in the parent file (claim 7 of the patent). The arguments presented by

these two sources must now be relied upon to define why the present claims 20 and 44-58 would also be considered allowable over the same art. However, the present arguments in response to the last office action do not coincide with those reasons stated 21 October 1993 as outlined below.

Appellant respectfully invites the Examiner's attention to the language of 35 U.S.C. §251, which expressly contemplates the right of an applicant to be granted a "reissued patent ... enlarging the scope of the claims of the original patent" The Examiner's reasoning seeks to incorrectly place a restriction upon the Appellant's right, by asserting that 35 U.S.C. §251 *sub silentio*, requires that claims that enlarge the scope of the claims of the original patent be allowable for the identical reasons argued by an applicant in support of the allowability of the original claims. This is not the law under 35 U.S.C. §251. Accordingly, this rejection can not be maintained.

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B. Does 35 U.S.C. §251 Require That Reissue Claims Which Are Broader In Scope Than The Patent Claims Contain All Of The Constituent Elements Of The Narrowest One Of Those Patent Claims, Even Though The Reissue Claims Are Directed To Subject Matter That Is Different From That Defined By The Patent Claims?

In support of this rejection of claims 20 and 44 through 58, the Examiner reasons that:

"The present rejected claims do not include 'checking for a key-data input signal from said keyboard or remote control during a system power standby mode' as required by arguments supported by Applicant found in the Opinion of the Board of Appeals."

This reasoning ignores the fact that there are eight apparatus and process patent claims, all of which differ in language and scope, and ignores the fact that of these eight claims, the Opinion of the Board of Appeals addressed only one claim. The Examiner's *idee fixe* appears to be that reissue claims 20

and 44 through 58 are directed to the same invention as the single claim before the Board of Appeals. The speciousness of this *idee fixe* is readily illustrated by even a cursory comparison of the single claim before the Board of Appeals with the language and scope of the seven patent claims that were allowed prior to the decision by the Board of Appeals. Claims 20 and 44 through 58 are directed to inventions different from those defined by the single claim allowed by the Board of Appeals in its Opinion.

Appellant respectfully invites the attention of the Board of Appeals to the language of 35 U.S.C. §251, which expressly contemplates the right of an Appellant to be granted a:

“reissued patent ... ***enlarging the scope*** of the claims of the original patent” 35 U.S.C. §251 (emphasis added).

The Examiner’s reasoning seeks to incorrectly place a restriction upon the Appellant’s right, by asserting that 35 U.S.C. §251 *sub silentio*, creates an estoppel that requires that claims that enlarge the scope of the claims of the original patent be allowable for the identical reasons argued by an Appellant in support of the allowability of the original claims. Moreover, the Examiner’s application of 35 U.S.C. §251 ignores, and fails to address the fact that claims 21 and 44 through 58 define subject matter that is different from that defined by patent claim 7.

*different
claims*

Patent claim 7 defines the interaction between the user and aspects of the embodiments disclosed such as the sequence of visual video displays that occur in dependence upon the state of the processor controlling the video and audio display and the locking, or unlocking, of the video display, while reissue process claim 20 is drawn to the ability of the user to have the video system respond to a code “by barring transmission” of a first video signal to the display apparatus, on the

basis of a code that was selectively generated in dependence upon an evaluation of content by the user. This combination differs from that defined by patent claim 7.

Independent process claims 44 and 48 differ from claim 7, by focusing upon the reception of a first lock-key data signal and a second lock-key data signal, generating corresponding character signals in response to the corresponding lock-key data signal and mixing the video signal with the corresponding character signals. Claim 44 differs from claim 48, by the process of locking the video signal and preventing application of the video signal to enable the mixing, in dependence upon a determination of coincidence between the first and second lock-key signal, while claim 44 defines a process of changing the unlocking state and the locking state in accordance with the determination. Patent claim 7 however, is directed to different subject matter, and encompasses a comprehensive category of video displays and prompts.

Independent process claim 55 differs from process claims 44 and 48, as well as from patent claim 7, by defining the changing of the locking state and unlocking state “in accordance with said mode change signal”, and in terms of the prevention and permission of the mixing of the video signal during the respective states. In contradistinction, patent claim 7 was directed to other aspects of the disclosure, including the clearing of the secret code, a feature not found in either process claims 20, 44 or 48, and claim 55 is directed to still different aspects of Applicant’s invention and are defined by patent claim 7.

Independent process claim 56 is directed to the change of the locking and unlocking states in combination with the generation, mixing and display of video images corresponding to the respective character signals. In contradistinction, patent claim 7 that the Examiner has fixated upon,

is devoid of the definition between the locked state and the successive entry of first and second lock-key data signals, as is defined by independent reissue process claims 44, 48, 55 and 56. Moreover, claim 7 does not purport to define the interaction between the first and second lock-key data signals and the dissemination of an audio signal, as is defined by Applicant's claim 56.

In essence, the Examiner has refused allowance of claims 20, 44, 48, 55 and 56 on grounds that these claims do not contain *all* of the four limitations that the Examiner has identified in patent claim 7, but the Examiner has ignored the fact that these finally rejected reissue claims are directed to different subject matter. The Examiner's application of §251 essentially limits a reissue applicant from presenting reissue claims for any subject matter that is not already defined by the patent claims. This is not the law under 35 U.S.C. §251. Accordingly, this rejection can not be maintained.

C. 35 U.S.C. §251 Does Not Prohibit Allowance Of Reissue Claims That Are Patentably Distinguishable Over The Prior Art For Reasons Different From The Patented Claims.

One flaw in this rejection of reissue claims 20 and 44 through 58 is that the Examiner's expressed rationale is wholly unsupported by either statute, rule of the Commissioner, or judicial interpretation of the statute. When the Examiner asserts that:

“[t]he arguments presented by these two sources must now be relied upon to define why the present claims 20 and 44-58 would also be considered allowable over the same art”,

the Examiner ignores the absence in 35 U.S.C. §251 of any language that prohibits the allowance of reissue claims that are patentably distinguishable over the prior art for reasons that are different from those reasons that distinguish the patented claims from the prior art. When the Examiner states

that,

“the present arguments in response to the last office action do not coincide with those reasons stated 21 October 1993 ”,

the Examiner is improperly endeavoring to limit a reissue applicant to only those claims that are patentably distinguishable over the prior art for the very same reasons as the patented claims. This necessarily limits the applicant to the presentation of reissue claims that are coincidental in breath and scope to the patented claims; such reissue claims would be essentially duplicates of the patented claims. The Examiner's endeavor ignores the express grant by 35 U.S.C. §251 of the patentee's right to obtain broader claims within a two year period after the issue of the patented claims. In short, the Examiner has no grant of authority under 35 U.S.C. §251 to reject **claims of enlarging scope that are allowable for reasons not enunciated by an applicant during the examination of the original patent** either in the *Remarks* or in an *Appeal Brief*, or by the Board in a *Decision on an Appeal*. The Examiner's statement that claims 20 and 44 through 58 are unpatentable under 35 U.S.C. §251 because:

“the present arguments in response to the last office action do not coincide with those reasons stated 21 October 1993 ”,

is specious. Accordingly, there is no lawful basis for maintaining a rejection of reissue claims of enlarging scope, even if those claims are allowable for reasons other than those either argued by the Appellant or stated by the Board of Appeals, during prosecution of the original patent. Withdrawal of this rejection and allowance of claims 20 and 44 through 58, is therefore requested.

II. Is There Evidence In The Instant Record To Fairly Justify A Rejection Of Claims 21 And 44 Through 58 Under The Doctrine Of Reissue Recapture?

A careful review of the entire prosecution history establishes that Appellant did not either disclaim or disavow the scope of coverage sought by reissue claims 21 and 44 through 58.¹ This recent guidance from the Federal Circuit sets the field of relevant inquiry for resolution of this issue.

D. The Examiner Has Not Correctly Followed The Procedure Established By The Commissioner Of The United States Patent & Trademark Office For Making A Determination Of An Improper Recapture Under 35 U.S.C. §251.

A rejection alleging improper recapture under 35 U.S.C. §251 must follow the procedures of the United States Patent & Trademark Office. A second flaw in the Examiner's reasoning lies in the Examiner's failure to recognize that nothing was surrendered during prosecution of the parent application. The Office action has alleged recapture without following the procedure mandated by the Commissioner. Application of the doctrine of recapture requires that the Examiner follow well defined procedural steps. Judicial interpretations of 35 U.S.C. §251 such as that set forth in *Pannu v. Storz Instruments Inc.*, 59 USPQ2d @ 1600 (Fed. Cir. 2001) earlier cited by the Examiner, details the three-step process for application of the recapture rule. The first step is to:

“determine whether and in what aspect the reissue claims are broader than the patent claims,”

¹ The entire statement is, “[a]lthough the above references, taken alone, may suggest some limitation of ‘bus’ to a multiplexing bus, **the remainder of the specification and prosecution history** shows that Rambus did not clearly disclaim or disavow such claim scope in this case.” *Rambus Inc. v. Infineon Technologies AG*, (Fed. Cir. 01/29/2003).

and the second step

“is to determine whether the broader aspects of the reissued claim relate to surrendered subject matter.”

As explained in §1412.02 of the *Manual of Patent Examining Procedure* (8th edition) (August 2001)),

“The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims.” *MPEP* §1412.02.

“The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter.” *MPEP* §1412.02.

The *Manual* instructs the Examiner that, in order:

“To determine whether an Applicant surrendered particular subject matter, we look at the prosecution history for arguments and changes to the claims made *in an effort to overcome* a prior art rejection.” *MPEP* §1412.02.

The practice outlined by the *Manual* is mandatory.

This rejection action is incomplete under 37 CFR §1.104(b) and (c) because the action not only fails to identify “in what **aspect** the reissue claims are broader than the patented claims” (that is, to make the first step required by *MPEP* §1412.02), but more significantly, fails “to determine whether the broader aspects of the reissued claims relate to surrendered subject matter” (the second step set forth in *MPEP* §1412.02). In short, this Office action has failed to identify any surrendered subject matter, as is required by the second step of *MPEP* §1412.02. As was discussed in Appellant’s response of the 7th of May 2002, the failure of the Office action to identify surrendered subject matter is directly attributable to the fact that careful examination of the prosecution history

establishes an absence of any evidence of record of a surrender of any subject matter during prosecution of the parent application.

Turning now to a review of the amendments made by the Appellant during the prosecution of the original patent, §1412.02 of the *Manual of Patent Examining Procedure* (8th edition) (August 2001)) instructs the Examiner, that:

“To determine whether an Applicant surrendered particular subject matter, we look at the prosecution history for *arguments and changes* to the claims made *in an effort to overcome* a prior art rejection.”
MPEP §1412.02.

The accompanying table illustrates the progress of examination of claims 2-9 in the parent application, which are now respectively numbered claims 1-8, and graphically illustrates that absence of the “*arguments and changes* to the claims made *in an effort to overcome* a prior art rejection” that are requisite to invocation of the doctrine of recapture, regardless of whether or not the doctrine may be applied to support a recapture.

Claim No.	Type	Amdt. 5/10/93	Amdt. 10/21/93	Office Action 11/23/93	Office Action 3/17/94	Amdt. 6/17/94	Advisory Action 6/23/94	Amdt. 6/30/94	Advisory Action 7/8/94	Board of App. 7/22/97
1	method	cancelled	cancelled	cancelled	cancelled	cancelled	cancelled	cancelled		
2	method			§103	allowed		allowed		allowed	
3	recorder		once	§103	§112¶2	twice	objection	thrice	allowed	
4	recorder		twice	§103	§112¶2		allowed		allowed	
5	recorder		once	§103	allowed		allowed		allowed	
6	recorder		twice	§103	§112¶2	thrice	allowed		allowed	
7	recorder		twice	§103	§112¶2		allowed		allowed	
8	method	new		§§102/103	§§102/103		§§102/103		§§102/103	allowed
9	method	new		§103	allowed		allowed		allowed	

The Preliminary Amendment of the 10th of May 1993 contained clarifying, rather than *Festo* type substantive amendments, to shift the dependencies of claims 4, 6 and 7, and to add independent method claims 8 and 9. In an Office action (Paper No. 5) of the 21st of July 1993, there were multiple and alternative rejections of all claims over Bonneau '623 and Amano '229. A responsive of Amendment filed on the 21st of October 1993, contained clarifying, rather than *Festo* type substantive amendments of independent apparatus claims 3 and 5. The rejections of claims 2 through 7 and 9 were repeated in the Office action of the 23rd of November 1993. Subsequently, in the Office action of the 17th of March 1994, independent method claims 2 and 9 and independent apparatus claim 5 were allowed. Subsequently, claims 3, 4, 6 and 7 were allowed after corrective amendments made on the 17th and 30th of June 1994 in response either to an objection or to a rejection under the second paragraph of 35 U.S.C. §112 alleging possible indefiniteness.

Patented claims 1 through 6 (*i.e.*, including independent method claim 2 and independent apparatus claim 5 in the table) did not recite the clause "checking for a key-data input signal from

said keyboard or remote control during a system power stand-by mode” when originally presented or when amended; these claims do not now contain that clause. There is therefore, no basis for the Examiner to assert that the doctrine of recapture requires the presence of this clause in the re-issue claims, because that clause was neither added to patented claims 1 through 6 during prosecution in an effort to avoid a prior art rejection, nor was that clause argued during prosecution as patently distinguishing patent claims 1 through 6 over the prior art. In short, that clause was not present and its wording was not an issue. The doctrine of recapture provides no basis for asserting that the clause “checking for a key-data input signal ... stand-by mode” should be present in the reissue claims 20 and 44 through 58, because that clause was already present in several, but not all of the patented claims when those claims were first rejected. Consequently, that clause was not both added to all of the claims and then argued “*in an effort to overcome* a prior art rejection” a condition precedent imposed by Office practice as defined by *MPEP* §1412.02, to imposition of a reissue recapture rejection.

Reference to the amendments made during prosecution of the original patent in the light of the foregoing table establishes that the phrases “a character generator”, “a mixer” and “an audio muting circuit” were already present in the claims prior to the first Office action. The “character generator” appeared in original claims 2, 3 and 5 as presented in the Preliminary Amendment filed on the 1st of March 1993. The “mixer” also appeared in independent method claim 2 and independent apparatus claims 3 and 5 in the amendment filed on the 1st of March 1993. The phrase “an audio muting circuit” appeared in dependent apparatus claim 4 and in independent apparatus claim 5 in the Preliminary Amendment of 1 March 1993 and independent method claim 9 newly presented in Appellant’s Supplemental Preliminary Amendment filed on the 10th of May 1993. All

of these phrases were present in the pending claims prior to issuance of the first Office action; as is explained in greater detail below, none of these phrases could be said to have been added to the claims by amendment in order “to overcome such prior art applied in the application which matured into the parent for which reissue is being sought”, as is explained by §706.02(£)(1) of the *Manual*.

Turning now from the amendments and examining the remarks made by the Appellant during the prosecution of the original patent, in the *Remarks* of Appellant’s response filed on the 21st of October 1993, Appellant traversed the rejections of claims 2 through 7 and 9 for several “reason(s)”, as was explained on page 12 of that response. These reasons were given in the alternative, and any one of these reasons was separately sufficient to require a withdrawal of the rejections of claims 2 through 7 and 9:

First, in those *Remarks* Appellant explained that the Examiner’s reliance upon a rejection of claim 1 was incorrect, because no rejection had been made of claim 1, and the Examiner had in fact acknowledged that claim 1 had been cancelled prior to the Office action.

Second, those *Remarks* explained that the Examiner’s rejection of these claims by reference to the terms of the rejection of method claim 8 was an incomplete rejection, simply because the wording, and thus the field of the subject matter covered by claim 8 was quite different.

Third, in the *Remarks* Appellant explained that one of the two, alternative primary references relied upon by the Examiner to support the several rejections under 35 U.S.C. §103, lacked a “character generator”, and could not make a *prima facie* showing of obviousness while the alternative primary reference lacked any showing of any technique for

incorporating its character generator into the first alternative primary reference without destroying the intended mode of operation of that first alternative primary reference. These features were already present in independent apparatus claims 3 and 5 and in independent method claim 9 prior to the rejection.

Fourth, Appellant also explained that neither reference contained such other features present in the rejected claims as a mixer. These features were already present in apparatus claims 3 and 5 and independent method claim 9.

Accordingly, Appellant's *Remarks* in the response dated 21 October 1993 traversing "the rejections of claims 2 through 7 and 9 for several "reason(s)" do not constitute the joint acts of "*arguments and changes* to the claims made *in an effort to overcome* a prior art rejection" that are requisite to invocation of the doctrine of recapture under the mandatory procedure of *MPEP* §1412.02. The Examiner must therefore, re-examine reissue claims 20 and 44 through 58 in accordance with *MPEP* §1412.02. The *Manual* explains the "criteria for determining that subject matter has been surrendered", by stating that:

"[i]f the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists. *MPEP* §1412.02.

These criteria are not met where the claims in the original application were allowed, without substantive amendment, over the applied prior art, and both Appellant's *Remarks* and the *Decision on Appeal* by the Board simply demonstrated numerous, alternative features of the original claims that each separately served to distinguish those claims from the prior art. In short, where the original

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claims are allowable over the prior art because the prior art fails to make a *prima facie* showing, the multiple act criteria required by the *Manual* are not satisfied. Appellant submits however, that in view of absence of the *Manual*'s multiple acts of a:

“limitation ... [that] was originally presented/argued/stated in the original application to make the claims allowable”,

and the demonstrated absence of the joint acts of :

“arguments *and* changes to the claims made in an effort to overcome a prior art rejection”,

no *impermissible* recapture exists under the *Manual*'s criteria; this rejection must be withdrawn and claims 20 and 44 through 58 allowed. Such action is respectfully requested.

E. Where Appellant correctly demonstrates that the prior art fails to teach what the Office action represented that art as teaching, Appellant's demonstration of that failure does not thereafter create a recapture estoppel that restricts the scope of reissue coverage to claims that recite what was lacking in the prior art.

As is explained in the foregoing paragraphs, in the Amendment filed on the 21st of October 1993, Appellant correctly explained that the two, alternative primary references relied upon by the Examiner to support the several rejections under 35 U.S.C. §103, lacked several particular structural components of some (*e.g.*, independent apparatus claims 3 and 5, and independent method claim 9) of the rejected claims, and could not support a *prima facie* showing of obviousness, and correctly explained that the Examiner's proposed combination could not be made without destroying the intended mode of operation of the primary reference. Under 35 U.S.C. §102, “[a] person *shall be entitled* to a patent *unless* -” When an applicant is demonstrating the absence of a *prima facie* showing of obviousness, the applicant is not arguing that particular limitations of the rejected claims

render those claims patentable and allowable under the statute, but rather, the applicant is simply explaining that the deficiencies in the Examiner's applied art fail to negate the patentability of those claims. Consequently, Appellant's demonstration in *Remarks* or in an *Appeal Brief* of the numerous deficiencies in the Examiner's rejections does not establish the "surrender" that is an essential condition prerequisite to invocation of the doctrine of recapture. Nowhere did Appellant argue that the features missing from the Examiner's art served to patentably distinguish a patent claim over the prior art; in the Amendment filed on the 21st of October 1993, Appellant simply demonstrated that there were multiple deficiencies in the art cited by the Examiner, and that those numerous deficiencies prevented the prior art from supporting a rejection under 35 U.S.C. §103. The fact that Appellant separately, and alternatively noted that any of these exemplary deficiencies required withdrawal of the rejections, does not create any basis for invoking the doctrine of recapture because Appellant simply demonstrated the impropriety of the rejection.

By way of a simplified analogy, if the Examiner had cited the first U.S. Patent Grant issued by George Washington on the 31st of July 1790 to Samuel Hopkins for his *Discovery in the Making of Potash and Pearl Ash* to support a rejection of claims 2 through 7 and 9 under 35 U.S.C. §103, and if, in the Amendment filed on the 21st of October 1993, Appellant had explained to the Examiner that the rejection was improper because Hopkins '001 lacked either a *character generator* or a *mixer* or a step of *checking for a key-data input signal from said keyboard or remote control during a system power stand-by mode*, neither 35 U.S.C. §251 nor the doctrine of recapture would thereafter require all of Appellant's reissue claims to contain either a *character generator* or a *mixer* or a step of *checking for a key-data input signal from said keyboard or remote control during a system power stand-by mode*. Appellant's citation of at least three distinct features, and the Board's citation of

several other features found to be lacking in the Examiner's art and in the Examiner's proposed combination does not mean that there ever after, reissue claims are limited to combinations that include one or more of these elements, particularly where the prior art not only lacked these elements, but could not have used these elements in the practice of their respective intended modes of operation. The mere fact that Appellant correctly demonstrated to either the Examiner, or the Board of Appeals, that the prior art failed to teach what the Office action represented that art as teaching, does not thereafter create a recapture estoppel that restricts the scope of reissue coverage to claims that recite what was lacking in the prior art.

Moreover, the fact that neither a *character generator* nor a *mixer* was present in patented independent method claim 7, which was subsequently allowed in response to the decision by the Board of Appeals, further demonstrates the fallacy of the Examiner's assertion that the reissue claims must recite certain limitations that are present in some of the patented claims, but absent from other patent claims. If patented independent claim 7 lacks these elements, the Examiner can not correctly require Appellant to include these elements in any of the reissue claims.

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F. Where the Office Action Fails To Make A Finding Of In What Aspects The Reissue Claims Are Broader Than The Patent Claims, and Fails To Provide Evidence That The Broader Aspects Relate To Surrendered Subject Matter, The Rejection Must Be Withdrawn.

The Examiner also asserts that:

“Claims 20 and 44-58 are related in scope to like process/method claims in the parent which require the four reasons stated in the prosecution history as discussed above.”

Nothing in 35 U.S.C. §251 requires that an applicant's claims of enlarging scope to be “related in scope to like process/method claims in the parent” patent. Where, as here, an applicant chooses to

use different nouns and verbs to define his invention, nothing in 35 U.S.C. §251 authorizes the Examiner to maintain a rejection on the grounds now asserted by the Examiner, namely that the rejected claims are not “related in scope to like process/method claims in the parent” patent. The Examiner’s reasoning is a *non sequitur* because claims of enlarging scope, by definition, must differ in scope, and can not therefore, be “related in scope to like process/method claims in the parent” patent. Consequently, the Examiner’s reason given for refusing allowance of claims 20 and 44 through 58 is contrary to logic, unauthorized by statute, and should not be maintained upon reconsideration.

G. May A Recapture Rejection Under 35 U.S.C. §251 Be Maintained Where The Office Action Fails To Make A Finding Of Which Aspects Of The Reissue Claims Are Broader Than The Patented Claims, And Fails To Provide Evidence That The Broader Aspects Relate To Surrendered Subject Matter?

The Examiner also asserts that:

“Claims 20 and 44 - 58 are *related in scope* to like process/method claims in the patent which require the four reasons stated in the prosecution history as discussed above.” Examiner’s comments, page 2, Paper No. 24.

Nothing in 35 U.S.C. §251 requires that an Appellant’s claims of enlarging scope to be “*related in scope* to like process/method claims in the parent” patent. Where, as here, an Appellant chooses to use different nouns and verbs to define his invention, or alternatively, to define inventions other than those defined by the patent claims,² nothing in 35 U.S.C. §251 authorizes the Examiner to maintain

² In its opinion in *Rambus Inc.*, the Court expressly recognized that a single patent may describe more than one invention. “In this case, the prosecution history shows that a multiplexing bus is only one of many inventions disclosed in the ‘868 application.”

a rejection on the grounds now asserted by the Examiner, namely that the rejected claims are not “related in scope to like process/method claims in the parent” patent. The Examiner’s reasoning is a *non sequitur* because claims of enlarging scope, by definition, must differ in scope, and can not therefore, be “related in scope to like process/method claims in the parent” patent. Consequently, the Examiner’s reason given for refusing allowance of claims 21 through 60 is contrary to logic, unauthorized by statute, and should not be maintained upon reconsideration.

H. The Examiner’s Rejection of Claims 20 and 44-58 Under 35 U.S.C. §251 Is An Improper, Back-door Attempt To Revive The *Point-of-novelty* Criterion For Patentability

The Examiner’s assertion that claims 20 and 44-58 are [?]related in scope to like process/method claims in the parent which require the four reasons stated in the prosecution history as discussed above”, the Examiner is, in effect, improperly re-writing U.S.C. §251 to require that the reissue claims contain the same point-of-novelty language as the patented claims. This ignores the fact that the point-of-novelty test has been long discarded by the Court of Appeals, that 35 U.S.C. §251 contains no point-of-novelty criteria and that the statute, as represented by sections such as 35 U.S.C. §103(a), mandates that the Examiner must consider the subject matter claimed *as a whole*, rather than as isolated limitations. Application of the point-of-novelty test ignores the fact that the reissue Appellant’s inventions may be alternatively defined by the interaction of the combination of constituent elements, rather than by a single point-of-novelty phrase. It is therefore, unreasonable to expect, and there is no requirement under §251, that the re-issue claims slavishly parent the language of the patented claims.

I. Alternative Statements Made By The Board Of Appeals To Explain A Refusal To

Sustain A Series Of Different Rejections Under 35 U.S.C. §§102 and 103 Are Not Attributable To The Appellant And Do Not Constitute A Surrender Of Patentable Subject Matter Under 35 U.S.C. §251.

The Examiner further argues the rejection of claims 20 through 44 through 58 on grounds that:

The present rejected claims do not include "checking for a key-data input signal from said keyboard or remote control during a system power standby mode" as required by arguments supported by Applicant found in the Opinion of the Board of Appeals.

The language referred to by the Examiner is the language of the Board of Appeals as written in its *Decision on Appeal*, rather than the language of the Appellant, and that language demonstrates in three distinct paragraphs Nos. 13, 14 and 16, **five** different reasons why Bonneau '623 fails to anticipate patented claim 7, and in two distinct paragraphs Nos. 22 and 24, **two** reasons why Amano U.S. 4,620,229 failed to anticipated method claim 8. Appellant has no right of appeal from a decision of the Board of Patent Appeals and Interferences, that completely reverses all rejections; consequently, whatever language may be employed by the Board in its opinion, does not create an estoppel or establish any basis for recapture, simply because the language is by the Board is not either controlled or subject to appeal by the Appellant. Moreover, in many instances, the Board bases its decisions upon factual considerations that are not argued or presented in the Appellant's Brief. Where, as here, the Board refused to sustain the Examiner's rejections of obviousness under 35 U.S.C. §103, but the "Appellant does not challenge the Examiner's rejections for obviousness in his Brief", there is no basis for the Examiner during the reissue prosecution, to claim that arguments presented by Appellant to the Board establish a basis for recapture. In short, no arguments were made by Appellant, as was noted by the Board in paragraph 8, on page 14, of the

its *Decision on Appeal*.

Moreover, the Examiner's assertion that the rejected claims do not include "checking for a key-data input signal from said keyboard or remote control during a system power standby mode" is factually incorrect; reissue claim 20 expressly defines a process for, inter alia,

"during said system power standby mode of operation, selectively generating a code in dependence upon said evaluation".

As earlier explained herein, even assuming *arguendo* the existence of some sort of bar to recapture in the instant application, the existence of that bar does not deny the Appellant the ability to broaden the scope of coverage by using alternative language to define his inventions. Nothing under the doctrine of recapture requires an Appellant to use the exact and precise language present in the patented claims. Furthermore, some of the patented claims, such as independent apparatus claims 2 and 4, broadly define alternative steps of either checking for an input signal or generating that input signal during a power stand-by state. Accordingly, there is no basis for maintaining a rejection of claims 20 and 44 through 58 on grounds that these claims lack language mentioned by the Board of Appeals in one of its numerous reasons for refusing to sustain any of the several art rejections of then claim 8.

J. Even Ignoring Arguendo A Lack Of Basis For Imposition Of A Rejection Under The Doctrine Of Recapture And A Failure Of The Examiner To Follow The Mandated Procedure Under MPEP §1412.02, Claims 20 And 44 Through 58 Each Define At Least One Of The Constituent Aspects Required By The Examiner

Considering again the Examiner's argument that the rejection of claims 20 through 44 through 58 on grounds that:

"[t]he present rejected claims do not include "checking for a

key-data input signal from said keyboard or remote control during a system power standby mode” as required by arguments supported by Applicant found in the Opinion of the Board of Appeals”,

the Examiner’s attention is invited to independent reissue claim 20, which defines, *inter alia*, steps of “during said system power standby mode of operation, selectively generating a code” Some of the original patent claims, such as independent method claim 1 broadly defines an alternative step of “when ... in said standby mode of operation, receiving a lock function code ...” and independent method claim 8 states “ checking for an input signal ... during a system power stand-by state ...”, while other original claims, such as independent apparatus claims 2 and 4, do not even allude to this aspect of Appellant’s inventions. Even ignoring *arguendo* the absence of evidence of record that supports an impermissible recapture, a fair reading of claim 20 shows the presence of one definition of this code generating aspect of Appellant’s inventions, a feature that is alternatively defined in different language by . Accordingly, this rejection should be withdrawn under the reasoning used by the Examiner.

In further support of the rejection, the Examiner also asserted that:

Alternatively, the following limitations must otherwise be present in these reissue claims where the scope is otherwise commensurate as argued with respect to then method claim 2, now method claim 1:

- a character generator: as stated in the arguments filed on pages 12-13, 21 October 1993;
- a mixer: as required on page 13, first paragraph, in the arguments filed on pages 12-13, 21 October 1993; or
- an audio muting circuit: as stated on page 13, last paragraph in the arguments filed on pages 12-13, 21 October 1993.”

Independent claims 44, 48, 55 and 56 however, which are process rather than apparatus claims,

expressly define these aspects of Appellant's inventions attributable to a character generator and those attributable to a mixer.

In Paper No. 24, the Examiner asserted that:

[t]he essential reasons argued for the allowability of the originally patented claims 2-6 and 9 according to Applicant exist in the amendment filed 21 October 1999 in the parent file and in the opinion of the Board of Appeals as originally numbered claim 8 in the parent file (claim 7 of the patent)."

The Examiner then argues that "the two sources must now be relied upon to define why present claims 20 and 44-58 would also be considered allowable over the same art." (Paper No. 24, page 2).

The Examiner fails to explain why "these two sources must *now* be relied upon to define why claims 20 and 44-58 would also be considered allowable over the same art.

Moreover, Applicant's amendment of the 21st of October 1993 devotes pages 7 through 11 to discussion of the alternative rejections of patent claim 7 under 35 U.S.C. §102(b) and 35 U.S.C. §103, over either Bonneau et al. or Amano et al. Subsequently, in pages 12 through 13 of the amendment of the 21st of October 1993, Applicant separately discusses the rejections of claims 2-7 and 9 (now patent claims 1-6 and 8) as rejected under 35 U.S.C. §103 over a proposed combination of Bonneau et al. and Amano et al. The language of patent claim 7 differs substantially from the language of patent claim 1-6 and 8, and the arguments and remarks set forth in the amendment of the 21st of October 1993 correspond to the language of the respective claims. By way of example, on page 13, Applicant explained that Bonnea does not "include an audio muting circuit" and "does not teach muting the audio"; consequently reissue claim 56 which addresses controlling the audio signal, corresponds to dependent patent claim 3, rather than to patent claim 7, which claims neither audio muting or an audio muting circuit. The Examiner's insistence that reissue claim 56 include

the novel features of patent claim 7 is therefore misplaced, in view of the gross distinctions between the subject matter covered by patent claims 3 and 7, and the gross differences between patent claim 7 and reissue claim 56.

Patent claim 55 contemplates, among other features, “locking and unlocking said video signal in dependence upon” a “determination whether said second lock key signal is identical to a reference” Patent claim 7 addressed in the Opinion of the Board and in pages 7 through 11 of Applicant’s amendment of the 21st of October 1993, contains no video muting step and no video muting circuit 107, a feature of patent claim 4, rather than patent claim 7 which was the subject of the earlier Appeal to the Board. Patent claim 4 lacks any “system power standby” aspect, and is therefore more similar to reissue process claims 55 and 56. Consequently the Examiner’s insistence that process claims 55 and 56 include features found in patent claim 7, not only ignores the difference in scope between patent claims 4 and 7, but the fact that patent claims 4 and 7 are directed to different subject matter. The Examiner’s assertion that the arguments presented in Applicant’s amendment of the 21st of October 1993 to justify patentability of process claims 55 and 56 is therefore unfounded, when patent claim 4 lacks the features associated with Applicant’s “*system power standby mode*” aspect of patent claim 7.

Furthermore, the Examiner suggests that the “character generator”, “mixer” and “audio muting circuit” be present in the reissue claims. Applicant notes that patent claim 2 contains no audio muting circuit, while reissue claims 55 and 56, although process claims, expressly contemplate both “mixing” and generation of character signals, as well as either “preventing said mixing of said video signal during said locking” claim 55 or “preventing dissemination of said audio signal during said locking state” (as defined by reissue claim 56). It is difficult to understand therefore, in view

of the express correlation between process claims 55 and 56 and the Examiner's statements on the bottom of page 2 and the top of page 3 in Paper No. 24, why the Examiner has continued to reject process claims 55 and 56. These claims meet the express requirements enunciated in Paper No. 24. The rejection should not be sustained.

Neither reissue claims 48 nor 44 define Applicant's "system power standby mode" of patent claim 7. Both claims however, expressly generate character signals and mix video signals, in conformance with the Examiner's insistence upon the language of method claim 1 set forth at the bottom of page 2 of Paper No. 24. Why the Examiner focused upon the language of patent claim 1 in listing the character generator, mixer and audio muting circuit in Paper No. 24 is unclear. Independent apparatus claim 2 does not define either a video or an audio muting circuit; these features are found in dependent claim 3. Consequently, the Examiner's insistence that the audio muting circuit of dependent claim 3 be incorporated into independent reissue claims 44 and 48 ignores the breadth of patent claim 2, and improperly denies Applicant's right accorded under 35 U.S.C. §251 to seek broader coverage, by insisting that Applicant amend reissue claims 44 and 48 to incorporate the limitations drawn from dependent patent claim 3. The Examiner cites no authority for his insistence. In a minimum, 35 U.S.C. §251 envisions that Applicant should be able to obtain a reissue claim having a scope at least as broad as independent patent claim 2. Furthermore, the fact that reissue claims 48 and 44 contemplate the character generation and mixing of video signals defined by the character generator and mixer set forth in the bottom of page 2 of Paper No. 24, establishes that reissue claims 48 and 44 are allowable under §251 and the doctrine of reissue recapture, under the criteria enunciated by the Examiner in Paper No. 24. These rejections should not be sustained.

In Paper No. 24, the Examiner explains the rejection of claim 20 and claims 44-58 under 35 U.S.C. §251 and the theory of reissue recapture, by stating that these reissue claims must be “related in scope to like process/method claims present in the parent.” The Examiner fails to consider however, that allowability of a reissue claim must be determined on the basis of the entirety of the claim, and not upon the presence or absence of particular single limitations. The Examiner focuses upon Applicant’s “system power standby mode”, and Applicant notes that this feature is expressly recited in lines 6 and 7 of process claim 20.

The Examiner then asserts that process claim 20 lacks any feature of “checking for a key-data input signal from said keyboard or a remote control” during the “system power standby mode.” Independent patent process claim 1 defines the process step of “when ... in said standby mode of operation, receiving a lock function code from said input device” while reissue claim 20 defines the step of “during said power standby mode of operation, selectively generating a code in dependence upon said evaluation. Paragraph 13, on page 15 of Paper No. 35, the findings of fact and conclusions of law issued by the Board on the 22nd of July 1997, determined that “neither of the references teaches or suggests a reason to initiate the lockout while the system power is off.” The Board recognized that it would be “simple enough to modify” these references, but that the Board saw “no motivation to do so.”

The language of patent method claim 1 and the explanation set forth by the Board in its Findings establish, is that it is the initiation of “the lockout operation while the system power is off” that is not found in the art, as opposed to the Examiner’s assertion that the narrower step of “checking for a key-data input signal from a keyboard or a remote control” during the “system power standby mode” is not found in the art. Claim 20 contemplates the initiation of “the lockout

operation” *during said system power standby mode operation*, and expressly defines this in lines 6 and 7. In short, process claim 20 complies with the reasoning given by the Board in its findings as well as conforms to the language of independent patent process claim 1.

Furthermore, independent patent apparatus claim 2 contemplates operational steps that are defined independently of the system power standby mode operation and instead defines the “input device providing a coded sequence and a lock function signal”, while independent apparatus patent claim 4 contemplates “a microcomputer responsive to input signals from a keyboard or a remote control receiver; both patent claims 2 and 4 operate upon the input signals received to control the transmission of the video signal, as by video muting. Reissue process claim 20 also responds to the code by “barring transmission of said first video signal to said video display apparatus.” Accordingly, the conformance of reissue claim 20 to apparatus patent claims 2 and 4 together with the explanation given in Paper No. 24 establishing that the art of record did not teach or suggest initiation of “a lockout operation while the system power is off”, shows that there is no basis for maintaining the reissue recapture rejection of reissue claim 20.

Ignoring again *arguendo* the absence of evidence of record that supports an impermissible recapture, a fair reading of process claims 44, 48, 55 and 56 shows the presence of both the character generating and mixing aspects of Appellant’s inventions. Accordingly, using the same reasoning employed by the Examiner, this rejection of claims 44 through 58 may not be sustained.

K. Ignoring Arguendo The Lack Of Basis For Imposition Of A Rejection Under The Doctrine Of Recapture And A Failure Of The Examiner To Follow The Mandated Procedure Under MPEP §1412.02, Claims 20 And 44 Through 58 Each Define Subject Matter That Appellant Considered As His Invention

In Paper No. 24, the Examiner focuses upon “[t]he essential reasons argued for the allowability of the originally patented claims 2-6 and 9 in the amendment filed 21 October 1999 ... and in the opinion of the Board of Appeals as originally numbered claim 8 in the parent file (claim 7 of the patent),” and then asserts that:

“the[-se] two sources must now be relied upon to define why present claims 20 and 44-58 would also be considered allowable over the same art.” (Paper No. 24, page 2).”

The Examiner fails to explain why “these two sources must *now* be relied upon to define why claims 20 and 44-58 would also be considered allowable over the same art. The Examiner has confused the issue of recapture with the issue of whether the reissue claims are for the same invention as that disclosed as “being the invention claimed in the original patent.”³

The entire prosecution history must be considered under §§1412.01 and 1412.02 of the *Manual* ⁴, and that consideration must be in accordance with the guidance recently given by the Federal Circuit. ⁵ As earlier demonstrated here in the foregoing arguments, that consideration

³ MPEP §1412.01 - Reissue Claims Must Be for Same General Invention

⁴ “The Examiner should review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant’s arguments made therein. The record of the original application must show that the broadening aspect (the omitted/broadened limitation(s)) relates to subject matter that applicant previously surrendered.” MPEP §1412.02.

⁵ The entire statement is, “[a]lthough the above references, taken alone, may suggest some limitation of ‘bus’ to a multiplexing bus, **the remainder of the specification and prosecution history** shows that Rambus did not clearly disclaim or disavow

establishes that Appellant did not either disclaim or disavow the scope of coverage sought by reissue claims 20 and 44 through 58. The Examiner has, in essence, erroneously substituted, albeit incorrectly, a consideration of “same invention” requirement under 35 U.S.C. §251 that reissue claims must be for the same invention as that disclosed as being the invention in the original patent, with the question of reissue recapture.⁶ The Examiner’s error lies in substituting individual statements made in the remarks of amendments or responses, or findings of fact by the Board, for the evidence of amendments made to the claims in order to overcome art rejections.⁷ The findings of fact required by the Commissioner in a “same invention” inquiry under 35 U.S.C. §251, as written in *MPEP* §1412.01 to support a finding of “an intent not to claim the subject matter of the claims presented in the reissue application ...”, are inapplicable to the consideration of the prosecution history required to determine whether an applicant has deliberately, previously surrendered the

such claim scope in this case.” In short, the Federal Circuit urges caution that isolated statements found in the prosecution history can not be the evidentiary basis on which to find a disavowal or disclaimer of inventions sought to be asserted after issue of the patent, such as during infringement or as here, in a reissue application. *Rambus Inc. v. Infineon Technologies AG*, (Fed. Cir. 01/29/2003).

⁶ “Merely finding that the subject matter was ‘not originally claimed, not an object of the original patent, and depicted in the drawing’ does not answer the essential inquiry under the ‘original patent’ clause of §251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees. In short, the absence of an ‘intent’, even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply not enough to establish that the new claims are not drawn to the invention disclosed in the original patent.” *MPEP* §1412.01, citing *In re Amos*, 21 U.S.P.Q. 2d 1271, 12274 (Fed. Cir. 1991).

⁷ *MPEP* §1412.01, and its apt excerpt from the opinion of the Federal Circuit in the *In re Amos* decision, cautions that “the absence of an ‘intent’, even if objectively evident from the earlier claims, the drawings, or the original objects of the invention is simply **not enough** to establish that the new claims are not drawn to the invention disclosed in the original patent.”

subject matter covered by a reissue claim that differs from a patent claim by an omitted limitation.

The Examiner's error arises from the failure to recognize that Appellant invented and disclosed more than the inventions covered by the patent claims.

IX. CONCLUSION

First, the Examiner's reasoning seeks to incorrectly place a restriction upon the Appellant's right, by asserting that 35 U.S.C. §251 *sub silentio*, creates an estoppel that requires that claims which enlarge the scope of the claims of the original patent be allowable for the identical reasons argued by an Appellant in support of the allowability of a single one of eight patent claims. This approach to reissue examination intrinsically either requires identification an examination of a point of novelty in the patent and reissue claims, or alternatively restricts to scope of coverage of issue claims to that of the patent claims, and forestalls an applicant's right to seek reissue claims directed to features and aspects that are different from those defined by the patent claims. Such is not the law under 35 U.S.C. §251. Accordingly, this rejection can not be maintained.

Second, the foregoing review of the entire prosecution history in accordance with the guidance recently given by the Federal Circuit ⁸ establishes that Appellant did not either disclaim or disavow the scope of coverage sought by reissue claims 20 and 44 through 58. Thus, there is no evidence in the record before the Board which would fairly establish that the Appellant disclaimed or disavowed that subject matter disclosed in the original application which does not include particular limitations found in patent claim 8. In short, there is no basis in the record to now invoke the doctrine of reissue recapture. Accordingly, the final rejection of claims 20 and 44 through 58

⁸ The entire statement is, "[a]lthough the above references, taken alone, may suggest some limitation of 'bus' to a multiplexing bus, **the remainder of the specification and prosecution history** shows that Rambus did not clearly disclaim or disavow such claim scope in this case." In short, the Federal Circuit urges caution that isolated statements found in the prosecution history can not be the evidentiary basis on which to find a disavowal or disclaimer of inventions sought to be asserted after issue of the patent, such as during infringement or as here, in a reissue application. *Rambus Inc. v. Infineon Technologies AG*, (Fed. Cir. 01/29/2003).

may not be sustained.

In view of the law and facts stated herein, as well as all of the foregoing reasons, Appellant believes that the rejection is improper, and respectfully requests that the Board refuse to sustain the outstanding rejection of claims 20, and 44 through 58 based upon this formulation and this application of the doctrine of recaptured subject matter.

Respectfully submitted,



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X. APPENDIX

CLAIMS UNDER APPEAL (Claims 20, 44-58)

1 20. (Twice Amended) A process for operating a video system, comprising:

2 making a subjective evaluation of content portrayed by a first video signal to be
3 transmitted for reception by a video display apparatus exhibiting a system power standby mode of
4 operation and a second mode of operation providing varying visual images corresponding to said
5 first video signal;

6 during said system power standby mode of operation, selectively generating a code
7 in dependence upon said evaluation; and

8 responding to said code by barring transmission of said first video signal to said video
9 display apparatus.

1 44. (Amended) A process for locking and unlocking a signal, comprising the steps of:

2 receiving from a keyboard a first lock key data signal;

3 generating a first character signal in response to said first lock-key data signal;

4 generating a video signal reproduced from a recording medium;

5 mixing said video signal and said first character signal;

6 displaying on a screen a first image representing said video signal and said first
7 character signal;

8 receiving a second lock-key data signal after receiving said first lock-key data signal;

9 generating a second character signal in response to said second lock-key data signal;

10 mixing said video signal and said second character signal;

11 displaying on a screen a second image representing said video signal and said second

12 character signal;

13 making a determination of whether said second lock-key data signal is identical to

14 said first lock-key data signal;

15 locking said video signal and preventing application of said video signal to enable

16 said mixing in dependence upon said determination.

1 45. The process of claim 44, further comprised of the step of:

2 releasing said locked video signal and applying said video signal to said mixer after

3 said video signal has been prevented from being mixed with said character signal.

1 46. The process of claim 44, further comprised of the steps of :

2 generating an error message signal in accordance with said determination when said

3 second lock-key data signal is not identical to said first lock-key data signal;

4 mixing said error message signal with said video signal; and

5 displaying a third image representing said error message signal and said video signal.

1 47. The process of claim 44, further comprised of the steps of:

2 generating an audio signal reproduced from said recording medium; and

3 locking said audio signal and releasing said muted video signal in dependence upon

4 said determination.

1 48. A process for locking and unlocking a signal, comprising the steps of:
2 receiving a first lock key data signal;
3 generating a first character signal in response to said first lock-key data signal;
4 generating a video signal reproduced from a recording medium;
5 mixing said video signal and said first character signal;
6 displaying a video image representing said video signal and said first character signal;
7 receiving a second lock-key data signal after receiving said first lock-key data signal;
8 generating a second character signal in response to said second lock-key signal;
9 mixing said video signal and said second character signal;
10 making a determination whether a locking state of barring said mixing of said video
11 signal or an unlocking state of permitting said mixing of said video signal is in effect; and
12 changing said unlocking state and said locking state in accordance with said
13 determination.

1 49. The process of claim 48, further comprised of the step of locking said video signal
2 and barring said video signal from being mixed with said second character signal in response to said
3 determination when said unlocking state is in effect.

1 50. The process of claim 48, further comprised of the step of making a second
2 determination of whether said second lock-key data signal is identical to a reference.

1 51. The process of claim 50, further comprised of the step of changing said unlocking
2 state and said locking state in dependence upon said second determination.

1 52. The process of claim 50, further comprised of the step of generating an error message
2 signal in response to said second determination when said second lock-key data signal is not
3 identical to said reference.

1 53. The process of claim 50, further comprised of the steps of:
2 mixing said video signal and said error message signal; and
3 displaying an error image representing said error message signal and said second character
4 signal.

1 54. The process of claim 48, further comprised of the steps of:
2 generating an audio signal reproduced from said recording medium; and
3 changing a lock state of preventing dissemination of said audio signal and an
4 unlocking state of disseminating said audio signal in accordance with said determination.

1 55. (Amended) A process for locking and unlocking a signal, comprising the steps of:
2 receiving a first lock key data signal;
3 generating a first character signal in response to reception of said first lock key data
4 signal;
5 receiving a video signal;

6 mixing said video signal and said first character signal;
7 receiving a second lock key data signal;
8 generating a second character signal in response to second lock key data signal;
9 mixing said video signal and said second character signal;
10 making a determination whether said second lock key data signal is identical to a
11 reference; and
12 locking and unlocking said video signal in dependence upon to said determination
13 by preventing said mixing of said video signal during said locking and permitting said mixing of said
14 video signal during said unlocking.

1 56. (Amended) A process for locking and unlocking a signal, comprising the steps of:
2 receiving a first lock key data signal;
3 generating a first character signal in response to said first lock key data signal;
4 receiving an audio signal;
5 mixing said first character signal and a first video signal;
6 displaying a first video image in correspondence with said mixing of said first
7 character signal and said first video signal;
8 receiving a second lock-key data signal after receiving said first lock-key data signal;
9 generating a second character signal and a mode change signal in response to said
10 second lock-key data signal;
11 mixing said first character signal and a second video signal;
12 displaying a second video image in correspondence with said mixing of said first

13 character signal and said second video signal; and

14 changing a locking state and an unlocking state of said audio signal in accordance
15 with said mode change signal by preventing dissemination of said audio signal during said locking
16 state and accommodating said dissemination during said unlocking state.

1 57. The process of claim 56, further comprised of the steps of:

2 generating a third video signal; and
3 changing between a locked state by preventing said third video signal from being
4 mixed with said character signal and an unlocked state of allowing said third video signal to be
5 mixed with said character signal in response to said mode change signals.

1 58. (Amended) The process of claim 56, further comprised of the steps of:

2 making a determination of whether said second lock-key signal is identical to a
3 reference;
4 generating an error message signal in accordance with said determination when said
5 second lock-key signal is not identical to said reference;
6 mixing said character signal and said error message signal; and
7 displaying an error image representing said character signal and said error message
8 signal.